

**Claim Rejections Pursuant to 35 U.S.C. §102(e)**

Claims 1, 12, 14, 15, 18, 21, 23, 25, 27-29, 31, 32 and 44-47 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,492,005 to Ohbayashi et al. Applicant traverses these rejections, and deems them overcome, for at least the following reasons:

Ohbayashi et al. fails to disclose all claim elements of independent Claim 1.

35 U.S.C. 102(e) recites:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Accordingly, MPEP 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

**Regarding Claim 1:**

The Examiner argues that Ohbayashi et al. includes all the elements of the present invention. Applicant respectfully and strongly disagrees.

Ohbayashi et al. does not teach a layer which provides a high-holdout for the claimed barrier layer. The Examiner asserts that the polyethylene coat of Ohbayashi et al. is equivalent to the barrier layer of the current application. Assuming this assertion is correct, Ohbayashi et al. has, as its primary layer on its paper, that which is defined in the present invention as the "barrier layer." In contrast, the present invention additionally provides for an under coat which may

provide for, among other things, a high-holdout pre-coat. (See the present application at page 4, line 4). Thus, the present invention teaches two layers, namely an under coat layer that provides high holdout for the separate barrier layer, and a barrier layer, while Ohbayashi teaches only one layer, namely a barrier layer.

Additionally, Ohbayashi et al. does not inherently teach the surface energy value of the barrier layer and Applicant thus respectfully requests that the Examiner cite evidence of the stated inherency, rather than mere reliance on the Examiner's opinion that Ohbayashi et al. inherently teaches a surface energy value. MPEP §2112 states in pertinent part:

**EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY**

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing

the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

Thus, the burden of proof is on the Examiner, not the Applicant, to show, by extrinsic evidence, that the claimed surface energy valve of the barrier layer is present in Ohbayashi et al. as identified by the Examiner. The mere statement of Examiner's opinion of such inherency is insufficient support for a rejection under §102(e).

Ohbayashi et al. thus fails to teach, among other things, an undercoat as described, and the Examiner has failed to provide the required extrinsic evidence as to the asserted inherency of the surface energy valve of the barrier layer. Therefore, Ohbayashi et al. cannot anticipate Claim 1. *See MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §102(e) rejection of Claim 1, deems it overcome, and respectfully requests removal of the rejection.

#### **Claim Rejections Pursuant to 35 U.S.C. §103**

##### **Claims 19, 20, 22, 24, 26, 30, 35 and 49-51**

Claims 19, 20, 22, 24, 26, 30, 35 and 49-51 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. U.S. 6,492,005 to Ohbayashi et al. Applicant traverses these rejections for at least the following reasons.

The Examiner fails to make out a prima facie case of obviousness with respect to Claim 1.

35 USC §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Accordingly, MPEP 706.02(j) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As argued above, Ohbayashi et al., among other things, does not teach the use of an undercoat layer to provide, in part, a high-holdout pre-coat. Since Ohbayashi et al. does not teach the claim limitations of the present invention, Ohbayashi et al. cannot render obvious Claim 1 of the present invention. *MPEP 706.02(j) (... the prior art reference (or references when combined) must teach or suggest all claim limitations).*

In rejecting Claims 19, 20, 22, 24, 26, 30, 35 and 49-51 under 35 U.S.C. 103(a), the Examiner has set forth that:

One of ordinary skill in the art would have been motivated to adjust the amount of hydrophilic binder, cationic polymer, latex binder and inorganic particles[,] . . . adjust the amount of hardener in order to improve the reaction between the different groups of polymers . . . [and to] adjust the coating weight of the barrier layer and the backing layer in order to photograph quality

and minimize the tendency to curl. *Official Action dated June 19, 2003, at pages 5 and 6.*

Applicant respectfully requests that the Examiner provide support for the assertion for which Official Notice is taken. Applicant respectfully traverses these rejections for at least the same reasons as have been set forth with regard to Claims 1, 12, 14, 15, 18, 21, 23, 25, 27-29, 31, 32 and 44-47. Furthermore, Applicant further submits that there is no motivation or reasonable expectation of success in modifying Ohbayashi et al. by incorporating facts according to the Examiner's notice. The Examiner provides no support for such an assertion nor does the Examiner show, in any way, that even if presently true, this assertion would have been true at the time of the filing of the present application. Applicant requests that the Examiner provide a reference for this assertion, as provided for in MPEP §2144.03.

Consequently, Applicant traverses the 35 U.S.C. §103(a) rejections and respectfully requests their reconsideration and removal. In addition, Applicant asserts that independent Claim 1 is in a condition for allowance.

### **Dependent Claims**

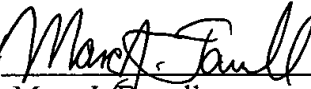
Further, Applicant submits that dependent Claims 6-15, 18-32, 44-47 and 49-51 are similarly in a condition for allowance, at least by virtue of their ultimate dependence upon a patentable base Claim 1. Applicant thus traverses the Examiner's rejections of dependent Claims 6-15, 18-32, 44-47, and 49-51 and respectfully requests their reconsideration and removal.

In view of the amendments and remarks included herein, it is respectfully submitted that the present application is in condition for final allowance and notice to such effect is respectfully requested. If the Examiner believes that additional issues need to be resolved before this application can be passed to issue, the undersigned invites the Examiner to contact him at the

telephone number provided below.

Respectfully submitted,

Dated: November 19, 2003

By   
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